UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,605	01/21/2000	William J. Baer	STL000023US1	6038

23373	7590	12/24/2003	

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20037

EXAMINER
NGUYEN, CAM LINH T

ART UNIT	PAPER NUMBER
2171	

DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/489,605	BAER ET AL.
	Examiner	Art Unit	
	CamLinh Nguyen	2171	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 November 2003*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
since a specific reference was included in the first sentence of the specification or in an Application Data Sheet.
37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific
reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>25</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

U.S. Patent and Trademark Office

PTOL-326 (Rev. 11-03)   Office Action Summary   Part of Paper No. 28

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

11/17/2003 has been entered.

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 1 – 18 are rejected under 35 U.S.C. 102(e) as being anticipated by

Reynolds et al (U.S. 6,411,993).

♦ As per claims 1, 6, 11,

Reynolds et al discloses a method for facilitating creation and manipulation of

compilations of content selected by a user, comprising:

- "Providing a functional layer for interfacing over a network with a user interface and interfacing with a data repository containing a plurality of content entities." See Fig. 3. In particular:

  - "A functional layer" corresponds to the "Ibook server application 64"

  - "Interfacing over a network" corresponds to the "data network 52"

  - "A user interface" corresponds to the "client 54, 58, 60"

  - "Interfacing with a data repository containing a plurality of content entities" corresponds to "databases 66 – 76"

- " The functional layer comprising a plurality of function modules, each function pertaining to the creation or manipulation of a compilation of content." The Ibook server application 64 handles different functions such as directs the overall operation of Ibook databases 66 – 72 (col. 5 lines 23 – 28), enrollment functions, downloading tools to the user (col. 5 lines 67 – col. 6 lines 6), generating a viewer ID (col. 6 lines 32 – 33); therefore, the server must include plurality of modules to handle these functions.

- " The plurality of function modules receives request from the user via the user interface and returns information concerning the compilation of content" See Fig. 9, in particular:

  - "Request from the user" corresponds to the "request desired passage from server" element 200 in Fig. 9 col. 11 lines 34 – 43.

  - "The user interface" corresponds to the interface shown in Fig. 8.

- "Returns information concerning the compilation of content" Fig. 9,

    element 206, col. 11 lines 43 – 45.

◆ As per claims 2 - 3, 7 – 8, 12 – 13,

- "One of the function modules creates a list of content entity identifiers defining

    the content and order of a compilation." See col. 9 lines 36 – 50. The server

    application 64 cause information to be stored in databases including the

    identities, time/date which identify the order of information also can be stored.

    When the user view the information, this information can represents as a list (col.

    10 lines 45 – 57. The server also can provide an index that to be stored in

    database (col. 14 lines 46 – 51), or a list (col. 15 lines 54 – 60).

- " At least one function module manipulates the list to redefine the content" See

    col. 12 lines 9 – 11.

◆ As per claims 4 – 5, 9 – 10, 14 – 15,

- "The compilation is hierarchically structured and wherein on of the function

    modules creates an outline of containers and content entity identifiers." Reynolds

    teaches, "Various techniques may be used to represent the contents of ibook

    Web pages (e.g., the ibook Web pages in ibook Web pages database 76). For

    example, ibook Web pages may be represented by static data. Alternatively,

    ibook Web pages may be represented by code that is capable of generating the

    Web page contents, e.g., code that generates the entries of a table or list." See

    col. 15 lines 54 – 60. Therefore, the compilation can also represent as a

    hierarchically structured.

- A "list" corresponds to the "outline."

♦ As per claims 16 – 18,

- " One of the function modules calculates a price for the compilation of content"

See Fig. 10, col. 12 lines 4 – 22.

Response to Arguments

Applicant's arguments with respect to claims 1- 18 have been considered but are

moot in view of the new ground(s) of rejection.

Conclusion

1.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Cam-Linh T. Nguyen whose telephone number is 703-

305- 1951. The examiner can normally be reached on Monday - Friday from 8:00 am to

4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Safet Metjahic, can be reached on (703) 308- 1436. The fax phone number

for the organization where this application or proceeding is assigned is (703) – 872 -

9306.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is 703- 305-

3900.

Cam-Linh Nguyen
Art Unit 2171

LN

WAYNE AMSBURY
PRIMARY PATENT EXAMINER